

REMARKS

Favorable reconsideration of this application is requested in view of the above amendments and in light of the following remarks and discussion.

Claims 1-4, 8 and 12-15 are pending. Claim 1 is amended, claims 5-7 and 9-11 are canceled without prejudice or disclaimer, and new claims 12-15 are added. Support for the changes to the claims is self-evident from the originally filed disclosure, including the original claims, and therefore no new matter is added.

In the Office Action the claims are rejected under 35 U.S.C. § 102(b) and 103(a) in view of Japanese Publication No. 2000-343557 to Takashi et al. (Takashi). It is requested that the rejections of the claims be withdrawn, and that the claims be allowed, for the following reasons.

The present invention is directed to a sheet-shaped molded laminate including concave or convex portions. Specifically, independent claim 1 recites a laminated skin member including a sheet-shaped lamination structure and a decorative face. A resin base material is integrally injection molded on a face of the laminated skin member. Glass fibers are disposed in the resin base material. The laminated skin member includes a sheet-shaped foamed layer with a density equal to or greater than  $0.04\text{g/cm}^3$ , a sheet-shaped decorative skin member bonded to one face of the foamed layer and including the decorative face, and a sheet-shaped backing layer bonded to the other face of the foamed layer. Before the laminated skin member and the resin base material are integrally molded, an elastic modulus of the laminated skin member in a warping deformation preventive direction of the molded laminate is equal to or smaller than  $196\text{N}/25\text{mm}$  (width of a test piece of the laminated skin member:  $25\text{mm}$ ) with the laminated skin member being stretched by 33%.

The Office Action asserts that the claimed features of the elastic modulus of the laminated skin member, as recited in original and currently amended independent claim 1, are inherent in Takashi. This assertion is traversed for the following reasons.

MPEP § 2112(IV.) requires that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic” and that “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” (Underlining original). In this case, it is submitted that the extrinsic evidence does not make clear that the claimed elastic modulus of the laminated skin member is necessarily present in the molded article of Takashi.

The laminated skin member, as recited in original independent claim 1, includes a sheet-shaped foamed layer with a density equal to or greater than  $0.04\text{g/cm}^3$ , a sheet-shaped decorative skin member bonded to one face of the foamed layer, and a sheet-shaped backing layer bonded to the other face of the foamed layer. It is understood that the properties of these layers, such as density, thickness, cutting direction and composition, determine the claimed elastic modulus of the laminated skin member. Therefore, it is submitted that in the molded article of Takashi, each of these properties may or may not be similar to those that provide the claimed elastic modulus of the laminated skin member. Therefore, because these properties may or may not be similar to those of the claimed invention, the claimed elastic modulus is not necessarily present in the molded article of Takashi.

Further, Applicants have experimentally determined that the Office Action’s assertion is incorrect. As shown in Table 1 on page 20 of Applicants’ originally filed specification, a laminate structure including a foamed layer having a density of  $0.050\text{ g/cm}^3$  did not provide

an elastic modulus within the claimed range. Specifically, comparative example 3 indicates that such a laminated structure has an elastic modulus of over 235N/25mm, which is much higher than the claimed maximum elastic modulus of 196N/25mm.

As further indicated in Table 1, the laminated structure of comparative example 3 cannot provide the excellent resistance against warping and crushing provided by the laminate recited in the claims.

The Office Action also asserts that the claimed features of the elastic modulus of the laminated skin member, as recited in original and currently amended independent claim 1, are obvious in view of Takashi. This assertion is traversed for the following reasons.

MPEP § 2144.05(II) states that “[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation,” as asserted in the Office Action.

Importantly, however, the MPEP further requires that “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” Takashi does not discuss, to any extent, an elastic modulus in a warping deformation preventive direction. Thus, it would not be proper for the Office Action to maintain that Takashi, which does not discuss an elastic modulus in a warping deformation preventive direction, recognizes such an elastic modulus as a variable that achieves any particular result.

For the above reasons, it is requested that the rejections of independent claim 1 under 35 U.S.C. §§ 102(b) and 103(a) in view of Takashi be withdrawn, and that independent claim 1 be allowed.

Claims 2-4, 8 and 12-14 are allowable for the same reasons as independent claim 1 from which they depend, as well as for their own features. Therefore, allowance of dependent claims 2-4, 8 and 12-14 is requested.

It is submitted that because each of the outstanding grounds of rejection of the original claims are overcome for the above reasons, MPEP § 706.07(a) indicates that it would be improper for a subsequent action to be made final.

It is also submitted that the dependent claims recite further features that are not disclosed or rendered obvious by Takashi. By way of specific example, claim 2, which is not currently amended, recites that an elastic modulus of a laminated skin member in a warping deformation preventive direction of a molded laminate is set lower than an elastic modulus of the laminated skin member in a crossing direction to the warping deformation preventive direction. Contrary to the Office Action's assertions that such features are "inherent," as shown in Applicants' original Figure 8, and as described on page 13, lines 8-18 of the originally filed specification, it is submitted that the claimed relationship between the elastic moduli can be affected by an orientation at which a laminated skin member is cut from a roll member. These considerations are not discussed in Takashi, and therefore Takashi does not anticipate dependent claim 2.

Takashi also does not render obvious the claimed features recited in dependent claim 2. Specifically, because Takashi does not recognize relationships between elastic moduli in different directions as achieving any particular result, Takashi does not render obvious the claimed relationship between the elastic moduli.

The foregoing provides alternate grounds for the allowance of dependent claim 2.

Notwithstanding the above discussion, independent claim 1 is amended to recite that the laminate includes glass fibers disposed in a resin material, which is not disclosed or

rendered obvious by Takashi. The foregoing provides still further alternate grounds for the allowance of independent claim 1, as well as claims 2-4, 8 and 12-14 depending therefrom.

Independent 15 is allowable for reasons similar to those discussed above with respect to independent claim 1. Allowance of independent claim 15 is therefore also requested.

Consequently, for the reasons discussed in detail above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

Respectfully submitted,

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